



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,899	02/23/2004	Minoru Fujimori	2004_0290	5937

7590 07/21/2006

Thomas J. Kowalski, Esq.
FROMMER LAWRENCE & HAUG LLP
745 Fifth Avenue
New York, NY 10151

EXAMINER

WHITEMAN, BRIAN A

ART UNIT PAPER NUMBER

1635

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10782,899	Applicant(s) FUJIMORI ET AL.
Examiner Brian Whiteman	Art Unit 1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) The period for reply expires 3 months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) They raise the issue of new matter (see NOTE below);
- (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. Applicant's reply has overcome the following rejection(s): _____.
6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 22.
Claim(s) objected to: 20.
Claim(s) rejected: 4, 6, 7, 10-14, 16, 19, 21, 24 and 25.
Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 6/28/06
13. Other: See Continuation Sheet.

Continuation of 3. NOTE: The limitation 'bacterium belonging to the genus Bifidobacterium selected from the group consisting of Bifidobacterium adolescentis, Bifidobacterium longum, Bifidobacterium bifidum, Bifidobacterium pseudolongum, Bifidobacterium thermophilum, Bifidobacterium breve and Bifidobacterium infantis; having a promoter and terminator involved in expressing a gene encoding a histone-like DNA-binding protein belonging to the genus of Bifidobacterium' in proposed new claims would require further search and consideration and raise the issue of new matter.

Continuation of 11. does NOT place the application in condition for allowance because: In response to applicant's argument against the 112 enablement rejection that Argani supports practicing the claimed invention because the main objection is a convenient and reproducible method to genetically transform bacteria of the genus bifidobacterium, applicant's argument is not found persuasive because Argani supports the unpredictability of using the claimed genus of Bifidobacterium in the claimed invention because Argani teaches the inability of plasmids to replicate in B.animalis and other Bifidobacterium strains (page 113).

In response to applicant's argument against the 112 first paragraph enablement rejection that Yazawa (breast cancer research and treatment, Vol. 66, pp. 165-170, 2001) concludes that bacterium belonging to the genus of bifidobacterium can be used and the statement is not limited to B. longum, is not found persuasive because the statement by Yazawa does not provide the teaching lacking from the specification for practicing the full scope of the claimed invention without an undue amount of experimentation. In addition, the argument is not found persuasive because the article is a post-filing reference indicated that the claimed invention was not enabled as of the filing date. See MPEP2164.05(a).

The references cited for support of applicant's argument against the enablement rejection are not considered because the applicant failed to provide a showing of good and sufficient reasons why the articles are necessary and were not earlier presented. In addition, the references cited on the IDS have not been considered because the IDS is not accompanied by a statement under 37 CFR 1.97(e). Applicant's argument against the 112 second paragraph are moot because the argument is based on proposed new claims that have not been entered.

Applicant's argument against the 103 have already been addressed and are not found persuasive for the reasons of record. See final rejection mailed on 3/28/06.

Continuation of 13. Other: At page 12 of the response, Applicant set forth a request for an interview with the Examiner and the Examiner's supervisor in the event that the application was not found to be in condition for allowance. This request was attached to an amendment which must be acted on by the Office in a timely fashion. In the future, Applicant is invited to contact the Examiner's supervisor directly to arrange any interviews prior to the submission of amendments, so that any remaining issues can be discussed in a timely fashion..



RICHARD SCHNIZER, PH.D.
PRIMARY EXAMINER